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Attachment to the Reinstatement Request

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mail Stop NON-FEE AMENDMENT

Re Application of: )  
Coronel et al )  
Serial No. 09/618,708 )  
Filed: July 18, 2000 )  
For: LARGE MUTI-FUNCTION )  
INTEGRATED CIRCUIT DEVICE )

Group Art Unit: 2814  
Examiner: Wille, Douglas A.

Attorney Docket: 36-0032

Hon. Commissioner for Patents

**ELECTION IN REPLY TO RESTRICTION REQUIREMENT**

Dear Sir:

This reply is in response to the Office Action dated June 6, 2003. That Office Action purports to be responsive to the Petition to the Commissioner (now Director) filed with appropriate petition fees on February 20, 2003. Applicant recognizes that the Office Action initiated by Examiner is not a Commissioner's Decision, that the action undertaken by Examiner in the Office Action is not the relief sought in applicant's petition and that applicant's required response to the Examiner should not render applicant's petition moot.

Applicant's petition requests that the restriction requirement be withdrawn and that the withdrawn claims be reinstated and considered (e.g. for patentability). The present Office Action withdraws the original restriction requirement and, instead of considering the patentability of the withdrawn claims (claims 6-18, 19-23, 24-36 and 38-40), institutes a new and different restriction requirement, though one less onerous than the original.

The Office Action institutes a new restriction requirement, dividing the claims as originally filed in the application into two groups, and requires applicant to elect one of

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the groups for further proceedings. The groupings of the claims and the stated classification are as follows:

Group I	1-18, 37 & 38	385/37
Group II	19-36, 39 & 40	257/777

It is noted that original restriction requirement grouped and classified the claims as follows:

Group I	CI 1-5 & 37	257/83
Group II	CI 1-18 & 38	59/237
Group III	CI 19-23 & 39	359/118
Group IV	CI 24-36 & 40	257/777

Applicant respectfully requests that the restriction requirement be reconsidered and modified and/or withdrawn.

Applicant respectfully traverses the Examiner's decision to require election based on the claims as originally filed in the application instead of the claims as amended. During the prosecution of the application, claims were amended, cancelled and added. As a result the original claims are past history, and basing any restriction requirement thereon at the present stage of the proceedings, applicant submits, is somewhat of a fantasy.

Although a restriction requirement typically is asserted as the first action in a patent application (and, hence, is based on the original claims), Applicant knows of no requirement, Statute or Rule that compels Examiner to do so at that time. The imposition of a proper restriction requirement is at the Examiner's discretion and need not be imposed at all. Sometimes the claims may, through amendment and the prior art, develop at a later stage in the prosecution of the application in which the claims diverge in subject matter to such an extent that Examiner comes to the view that a satisfactory search cannot be accomplished of the entire subject matter and a restriction requirement is thereupon imposed. Thus, applicant submits, withdrawal of the original restriction requirement neither requires a new restriction requirement and certainly does not require any new restriction requirement to be based on a non-existent set of claims.

For the foregoing reason, Applicant respectfully requests that the foregoing restriction requirement be modified or withdrawn.

Further, Applicant submits that a restriction requirement is inappropriate and an abuse of discretion, because the claims of both Group I and Group II should be classified together, and that the different classifications asserted in the restriction requirement are incorrect. Applicant submits that the claims of both groups are classifiable in class 385/37, and that it is inappropriate to classify the claims of group II in class 257/777.

The Office Action states that the "means for replacing a defective wafer can be accomplished without an external device coupled to the data bus", and that "the subcombination has separate utility, such as a wafer to wafer interconnect." First, as reference to the description reveals, one wafer may be regarded as an "external device" relative to another wafer. Secondly, on reading the specification, one appreciates that the reparability is inherent in the structure of optical waveguide and wafer combination (classified in Class 385 subclass 37) and that the recitation of "means for replacing a defective wafer" is an inartful expression made by the patent attorney who originally prepared the application that is intended to refer to a feature inherent in the claimed structure, and does not reference any separate tools. Thus, both sets of claims cover the same subject matter.

The definition of class 385 given in the Classification Manual includes "*B. Nominally claimed structure, external to this class claimed in combination with apparatus under the class definition, is classified in this class unless provided for in the appropriate external class.*" For that reason claims that fall within class 385 are permitted to include nominally recited wafers and solid-state devices in addition to an optical waveguide.

On the other hand, the definition of Class 257 provides for active solid-state electronic devices. In the section of that definition entitled "Scope of the Class", the definition states "This subject matter **does not** include active solid-state devices combined with significant circuits." The bolding of the foregoing proscription is included in the classification manual for emphasis.

The claims to Group II in fact do combine solid-state devices with significant optical circuits. Hence, the subject matter of the claims of group II are proscribed by the definition. Therefore, in applicant's view, it is inappropriate to classify the subject matter of group II in class 257. By default, the claims of group II again fall back into class 385 subclass 37.

Even if one were to assume that the "means for replacing a defective wafer" referred to a separate tool, the claims of Group II do not fall in class 257, and clearly fit with the claims of group I in class 385 subclass 37. As should be clear from the specification, there is no overlap in the search.

Applicant notes that of the four original classifications given by Examiner to classify the original claims into four groups, only one of those original classifications are included in Examiner's new groupings, and a new class and subclass is introduced. Considerable time appears to have devoted in attempting to find a way to divide up the claims in the application in a way that withstands challenge, unsuccessfully applicant believes. In Applicant's view, perhaps the most efficient approach for both Examiner and Applicant to dispose of the present application may well be to examine the claims.

ELECTION. In order to be fully responsive, applicant elects the claims of Group I for further prosecution on the merits. This election is made WITH TRAVERSE. This election is also made without prejudice to applicant's right to receive a decision to its petition of the Commissioner and without prejudice to the continuance of applicant's appeal.

Applicant also is of the view that claims 41 and 42 are classifiable with the claims of Group I.

Respectfully submitted,



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